

**REMARKS/ARGUMENTS**

Favorable reconsideration of this application is respectfully requested.

Claims 1-34 are presently active in this application. Claims 1, 12, 14, 17, 18, 32, and 34 are presently amended to correct typographical and grammatical errors, to better clarify the invention, and to provide consistency in claim terminology throughout the claims, all without the introduction of any new matter.

The outstanding Action presented a rejection of Claims 12 and 13 under the second paragraph of 35 U.S.C. §112, a rejection of Claims 1-3 and 5-17 under 35 U.S.C. §103 over Bosco et al. (U.S. Patent No. 5,191,552, Bosco) in view of Tauhert ("Merger of the Century") in further view of Joao (U.S. Patent No. 6,347,302), a rejection of Claims 18-28 and 30-34 under 35 U.S.C. §103 over Bosco in view of Tauhert, and a rejection of Claims 4 and 29<sup>1</sup> under 35 U.S.C. §103 over Bosco in view of Tauhert and a PTO alleged admission under MPEP § 2144.03.

a.) The rejection under 35 U.S.C. §112, second paragraph

The present amendment is respectfully submitted to overcome this rejection in terms of correcting the Claim 12 typographical error ("fro" should be --for--) noted in the outstanding Action and changing the recital of "said one application" (actually recited as "said one software application" in line 3 of Claim 12) to --said operating software application-- to be consistent with the language of parent Claim 1. The typographical error in Claim 12 that recited "case" instead of --cash-- was also corrected.

In addition, Claim 1 was modified to change "operating software" to --an operating software application-- to provide correct antecedent basis for the recital of "said operating software application" in Claim 1, line 14, for example. Also, Claim 1 has been amended to

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<sup>1</sup> Item 8 on the top of page 15 begins with a statement of the rejection that is an exact repeat of the rejection of Claim 4 that appears as item 7 on page 14. The body of the rejection on page 15 lists Claim 29. It is assumed that the body of the rejection listing Claim 29 reflects the intended rejection.

clarify that the operating software application has a control selection interface portion that provides the control selection interface, to remove the redundantly recited "coverage," and to more correctly reference the previously recited "built commercial lines insurance policy" as the "commercial lines insurance policy being built."

Claim 14 has been amended to change the line three recital of "said one software application" to --said operating software application-- to be consistent with the language of parent Claim 1 and Claim 17 has been amended to correct a grammatical error.

Claim 18 has been amended to better clarify that the operating software application contains commercial lines insurance policy forms also provides the user enabled interface and that the operating software application is used to "build a selected commercial lines insurance policy "from one or more of said commercial lines insurance policy forms selected based on said data files with forms being selectively removed or added by the user enabled interface," as clearly taught at page 9, lines 3-7 of the specification and step 34 of Fig. 2.

Claim 32 has been amended to change the line three recital of "said software application" to --said operating software application-- to be consistent with the language of ultimate parent Claim 18.

In light of the changes made to the claims, it is respectfully submitted that Claims 1-34 clearly all comply with the second paragraph of 35 USC § 112 and that the withdrawal of the rejection made as to Claims 12 and 13 on this grounds is in order.

b.) The rejections under 35 U.S.C. §103

The rejection of Applicant's Claims 1-3 and 5-17 under 35 U.S.C. §103(a) as being unpatentable over Bosco in view of Tauhert and further in view of Joao is traversed.

In this regard, the assertions at page 3 of the outstanding Action that Bosco teaches an "operating software application being further operative to build the insurance policy from a -

selected one of available insurance policy forms or from added said insurance policy forms” in Figure 13; col. 6, lines 58-65; col. 19, lines 58-col. 21, line 20; or col. 23, lines 4-30 is not correct.

First in this regard, Figure 13 teaches no building of an insurance policy using standard policy forms that can be added to or deleted using the interface and neither does col. 6, lines 58-65. Instead, Fig. 13 shows workstation architecture and col. 6, lines 58-65, of Bosco explains the intended meaning of the term “CASE” as used by Bosco. The outstanding Action fails to explain what the there noted “association of all components of a plan of insurance for a client,” the “case ID number,” “identifying the associated client and sales office,” “activity processing dates,” or “information used to characterize the case” have to do with the claimed subject matter of building an insurance policy from a standard or added forms. In particular, there is no explanation of how this definition of “CASE” and the further noted “CASE” discussions of cols. 19-21 and 23 teach the Claim 1 required building of an insurance policy from a selected one of available standard insurance policy forms or from added insurance policy forms.

To the extent that the outstanding Action is apparently attempting to itself equate the term “case” (or an unidentified one of its component parts) to the claimed standard insurance policy forms or added insurance policy forms, this is not proper as the reference itself must clearly state this to be so. See *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) and the court’s requirement that there must be relevant evidence as a reasonable mind might accept as adequate to support a conclusion that seemingly different terms mean the same thing.

Also, the artisan would understand that as disclosed here and by any customary usage given the language insurance policy form, the term “CASE” does not refer to an insurance policy form. It is the use of the words in the context of the written description and as

customarily used by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims. *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003).

Just as the "CASE" teachings of col. 6, lines 58-65 of Bosco are not relevant to teaching the building of insurance policies using the claimed "forms" subject matter, the "case" teachings of col. 19, lines 58-col. 21 line 20 also do not teach the Claim 1 required building of insurance policies from a selected one of available standard insurance policy forms or from added insurance policy forms as further improperly asserted. All that is taught at col. 19, line 58 to col. 21, line 20 of Bosco is that different types of GROUP insurance (Medical, Life, Dental, Long Term Care, Disability Income, AD&D) can make up the "CASE" content for each client, which does not teach anything about building any particular one of these different types of group insurance policies from a selected one of available standard group insurance policy forms or from added group insurance policy forms. Col. 23, lines 4-30 of Bosco relate to accessing menu options based on entry of client or case identity, not the Claim 1 required building of any insurance policy from a selected one of available standard insurance policy forms or from added insurance policy forms as further improperly asserted.

The teachings of Tauhert are further misstated by the outstanding Action. In this regard, Tauhert does not teach an Internet system for issuing and administering commercial lines insurance policies at page 49-50 as asserted. Instead, this meager description at best suggests that "the insurer has just Internet-enabled its application for agents to rate, quote and issue commercial lines policies, a process that previously required agents to call in or fax quotes, or to use proprietary dial-up access, which Beecher says was 'cumbersome' and 'expensive.'" Also, while the suggestion of issuing a commercial lines insurance policy

appears here, the manner it would be done is not disclosed, particularly not in terms of the operating software application of Claim 1, for example. Instead, the thrust of the suggestion appears to be that the agents use the Internet to “ask questions” and then access some other application to actually issue a policy, where there is no hint of using standard or non standard policy forms as to any actual building the suggested policy in this meager disclosure. Clearly, Tauhert does not cure the deficiencies of Bosco.

Moreover, the information needed from individual companies to write commercial lines insurance policies in terms of gathering specific data as to the location of property, the type of building, the building contents, etc. has no relevance to group insurance like the Bosco group Insurance for Medical, Life, Dental, Long Term Care, Disability Income, AD&D, etc. that apply to people, not property. Thus, the reason why the artisan would completely redesign Bosco to change the basic operating principle of processing data in order to provide client companies with group insurance coverage for their employees to the completely different task of gathering property data to be processed for issuing commercial lines insurance is a mystery and contrary to the case law. In this regard, any proposed modification that would change the basic operating principle of a reference has been established to not be an obvious one. *See In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959). Moreover, reference modifications that would render a reference unsatisfactory for its intended purpose, here the administering of group insurance of different types for client companies as taught by Bosco, has also been established to not be an obvious modification. *See In re Gordon*, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The only explanation for the proposed combination of Bosco and Tauhert appears in the only full paragraph on page 4 of the outstanding Action. This explanation is based on several distortions of reference teachings and lacks any logical conclusion based on the actual teachings found in these references. The first distortion is the assertion that Bosco “discloses

a system for rating, delivery and administering insurance policies.” However, the disclosure of Bosco is not relevant to a “system for rating, delivery and administering insurance policies” in general, rather it is directed to the provision of “[a]n integrated information storage processing and reporting system for **processing and supervising a plurality of group insurance accounts**” (emphasis added) based on data provided from “a single enterprise-wide relational data base.” See lines 1-4 of the Bosco abstract. To the extent that Bosco further teaches that this “system provides sales, underwriting, administration and actuarial functions through integrated program-controlled data processing systems specific for each function” (abstract, lines 4-7) it is always for selling, underwriting, administering and performing actuarial functions for the group insurance products of that enterprise. See *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA ‘965) (it is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what the reference fairly suggests to one of ordinary skill in the art.”).

Also, to whatever meager extent that Tauhert teaches “allowing agents and large corporate clients to ask questions over the ‘Net’ and enabling “agents to rate, quote and issue commercial lines policies,” these functions relate to issuing policies, not administering them as improperly stated in the above-noted paragraph on page 4 of the outstanding Action. Also, the statements noted at page 50 of Tauhert (as to allowing “the agent to have really fast turnaround of servicing customers” and allowing the agents and customers “to do the job with the least amount of manpower necessary”) relate to improvements over the previous process of rating, quoting and issuing commercial lines insurance that “required agents to call in or fax quotes, or to use proprietary dial up access.” See the sentence bridging pages 49 and 50 of Tauhert. No such requirements “for agents to call in or fax quotes, or to use proprietary dial up access” exist in the disclosed system of Bosco and the reliance on these teachings of

Tauhert to improve the Bosco system that does not require “agents to call in or fax quotes, or to use proprietary dial up access” is clearly misplaced and the required reasoning with some rational underpinning to support the legal conclusion of obviousness is lacking. See *In re Kahn*, 441 F.2d 977,988, 78 USPQ 2d 1329, 1336 (Fed. Cir. 2006).

Furthermore, even if the disclosure of Bosco did relate to a system of for issuing and administering its group insurance products that required “agents to call in or fax quotes, or to use proprietary dial up access,” all that Tauhert teaches is that use of the Internet to enable agents to perform these functions will reduce manpower and provide the noted “fast turnaround of servicing customers,” none of which teaches that these benefits require the abandonment of processing and providing group insurance products in favor of establishing a commercial lines insurance operation.

Moreover, the paragraph bridging pages 4 and 5 of the outstanding Action admit that even if combined, Bosco and Tauhert do not teach that the systematically entered data includes “basic policy information to identify an insured and effective date for the commercial lines insurance policy being built, the systematically entered data further including location information for the insured property and risk information based on any applicable construction characteristics of the insured property and any contents thereof, desired type of coverage and any desired liability limits, coverage, information including available options as to the subject matter to be covered by a particular commercial lines insurance policy being built or modified as well as providing a selection of forms for the particular commercial lines insurance policy” that is recited by base independent Claim 1. To cure this deficiency, the outstanding Action cites Joao for teachings found at col. 7, lines 23-50 and col. 8, lines 12-64.

However, the teachings of Joao do not apply to the group insurance products of concern to Bosco or to the Tauhert commercial lines insurance product. Instead, the teaching

of Joao relate to a third type of insurance product, i.e., lease insurance. Thus, col. 7, lines 23-50 of Joao teach gathering “[d]ata and/or information related to the leasing and/or rental of residential and/or commercial premises, which is included in the database 7” shown in FIG.

1. These teachings do not suggest that an agent is to ask questions of a corporate client over the Internet, like the improved processing suggested by Tauhert for issuing a commercial lines insurance product. Also, this “information related to the leasing and/or rental of residential and/or commercial premises” in data base 7 of Joao has nothing in common with the “single enterprise-wide relational data base” and the included “relational tables” described by Bosco (see, e.g., col. 2, lines 34-44 of Bosco).

Once again, the basic incompatibility of these three different systems and the complete redesign and change of operating principles that would be required to adapt Bosco to operate as a system for issuing the lease insurance product suggested by Joao has been ignored.

Moreover, the statement at col. 1, lines 6-12 of Joao relates specifically to providing “insurance products . . . for leased entities,” i.e., lease insurance products totally unrelated to the insurance products of Bosco and Tauhert. No explanation of why the artisan would even consider the lease insurance teachings of Joao to be relative to the different insurance products of Bosco and Tauhert is even offered. The above-noted “rational underpinning” noted in *Kahn, supra* is lacking.

This rejection of Claim 1 is thus traversed as there has been no reasonable explanation as to the suggested modification of Bosco by the teachings of Tauhert, and/or Joao. It is also traversed because the proposed modifications would change the basic operating principle of Bosco in violation of the holding in *In re Ratti, supra*, and would render Bosco unsatisfactory for its intended purpose of processing group insurance products in further violation of the holding in *In re Gordon, supra*.



Also being ignored is the fact that there is no teaching in any of Bosco, Tauhert, and/or Joao of building “the commercial lines insurance policy from a selected one of available standard commercial lines insurance policy forms or from added said commercial lines insurance policy forms using said policy processing data bases” as recited by Claim 1, for example.

In this regard, while col. 7, lines 23-50 of Joao may teach extracting certain kinds of data from the data base 7 noted at col. 7, lines 25-50 and col. 8, lines 12-64, to calculate risks to help design a suitable lease insurance product, there is no suggestion that this designing is done by use of any particular form or forms. Instead, col. 8, lines 51- 55 indicate that a “custom design” of the lease insurance product is what is taught.

As none of Joao, Tauhert, and or Bosco teach at least the Claim 1 required building of “the commercial lines insurance policy from a selected one of available standard commercial lines insurance policy forms or from added said commercial lines insurance policy forms using said policy processing data bases,” the 35 U.S.C. §103 rejection of Claim 1 is traversed. Also, the rejection of Claim 1 under 35 U.S.C. §103 over Bosco in view of Tauhert and in further view of Joao is traversed because it is well established that any proposed modification to a reference must be based upon logic and sound scientific reasoning, *see Ex parte Levengood*, 28 USPQ2d 1300, 1301 (Bd. Pat. App. & Int. 1993). Since no such logical and sound scientific reasoning has been presented in the outstanding Action to explain why the reference modification suggested would have been made by one of ordinary skill in the art, it is respectfully submitted that the rejection of Claim 1 is improper for this reason as well.

As claims 2-17 all depend from Claim 1 and as the PTO alleged admission-relied on as to Claim 4 does not cure the deficiencies noted above as to Bosco, Tauhert, and or Joao, the rejections offered s to Claims 2-17 under 35 U.S.C. § 103 are traversed for all the reasons noted above as to Claim 1. In addition, as Claims 2-17 add further features not taught or

suggested by Bosco, Tauhert, and or Joao, considered with or without the alleged admission relied on as to rejecting Claim 4, the rejections of these claims under 35 U.S.C. § 103 are traversed for these reasons as well.

Turning to method Claim 18, it is noted that the previous recital of this claim that the “operating software application” contains “commercial lines insurance policies and forms” has been emphasized by the present amendment that makes clear that the step of using the operating software application to build a selected commercial lines insurance policy is done by building “from one of said commercial lines insurance policies and forms selected by the user enabled interface.” As noted above as to apparatus Claims 1-17, none of Bosco, Tauhert, and or Joao, considered with or without the alleged admission relied on as to rejecting Claim 4, teach or suggest building a selected commercial lines insurance policy “from one of said commercial lines insurance policies and forms selected by the user enabled interface” (emphasis added).

Accordingly, the 35 U.S.C. §103 rejection of Claim 18 over Bosco in view of Tauhert is traversed for this reason.

Also, this rejection of Claim 18 is traversed because of the lack of the establishment of any reasonable basis from teachings or suggestions in Tauhert to modify Bosco, as set forth above, as well as because of the above-noted failure to present any “rational underpinning” or “logical and sound scientific reasoning” for the proposed modification of Bosco based on the noted teachings from Tauhert.

In this last regard, and as noted above, the only logical modification to Bosco based on the teachings from Tauhert would be the use of the Internet to enable agents to perform the Tauhert noted functions to reduce manpower and provide the above-noted “fast turnaround of servicing customers.” As further noted above, this adopting of the Internet to conduct communications between agents and clients does not require the abandonment of

group insurance products in favor of establishing a commercial lines insurance product operation.

Further, this rejection of Claim 18 is traversed because the proposed modifications would change the basic operating principle of Bosco in violation of the holding in *In re Ratti, supra*, and would render Bosco unsatisfactory for its intended purpose of processing group insurance products in further violation of the holding in *In re Gordon, supra*.

As Claims 19-34 all depend from Claim 18 and as the PTO alleged admission relied on as to Claim 29<sup>2</sup> does not cure the deficiencies noted above as to Bosco and/or Tauhert, the rejections offered as to Claims 19-34 under 35 U.S.C. § 103 are traversed for all the reasons noted above as to Claim 1. In addition, as Claims 19-34 add further features not taught or suggested by Bosco and/or Tauhert, considered with or without the alleged admission relied on as to rejecting Claim 29, the rejections of these claims under 35 U.S.C. § 103 are traversed for these reasons as well.

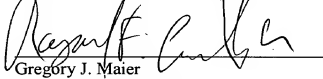
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<sup>2</sup> See footnote 1.

Consequently, in view of the foregoing amendment and remarks, it is respectfully submitted that no further issues remain outstanding in the present application, and that this application is clearly in condition for formal allowance and an early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Gregory J. Maier', is written over a horizontal line.

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